



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,747	11/13/2000	Richard L. Spagna	SOM920000016US1	8049

23334 7590 03/11/2005

FLEIT, KAIN, GIBBONS, GUTMAN, BONGINI  
& BIANCO P.L.  
ONE BOCA COMMERCE CENTER  
551 NORTHWEST 77TH STREET, SUITE 111  
BOCA RATON, FL 33487

EXAMINER

NGUYEN, CUONG H

ART UNIT PAPER NUMBER

3661

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/711,747

Applicant(s)

SPAGNA ET AL

Examiner

CUONG H. NGUYEN

Art Unit

3661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,11-16 and 18-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,11-16 and 18-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This Office Action is answer to the amendment received on 1/03/2005 from Mr. Jon A. Gibbons (Reg. No. 37,333) which paper has been placed of record.

2. Claims 1-16 are pending in this application. Claims 2, 10, and 17 are canceled. New claims 18-22 are added.

**Response**

3. The arguments and amendment of a subject matter for allowing an additional electronic content to be made are not persuasive.

Stefik teaches a use of a hash function for verification (another example is Johnson et al. (US Pat. 6,591,250) wherein a software token, and a hash value were used in electronic transaction for authentication, and verification 1:36-45, and 10:1-17). They are in the same field of endeavor and the use of a hash to obtain additional copy is old and well-known (please known that Stefik already suggests a claimed "intent-of-use" for "one additional copy has been authorized in the usage conditions associated with the previously received encrypted digital content and without the need to re-receive the encrypted digital content being copied", see Stefik, Fig.14 "Right 1450" and "Copy Count 1453", Fig.15, line 1502, and 1510 for counting number of allowable copies).

Serial Number: 09/711,747  
Art Unit 3661

In page 13, 1<sup>st</sup> para., the applicants argue that Yoshiura teaches away from "and without the need to re-receive the encrypted digital content being copied" - the examiner respectfully submits that the main reference of Stefik obviously suggests that "limitation".

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-9, 11-16, and 18-22 rejected under 35

U.S.C. 103(a) as being unpatentable over Stefik (US Pat.

5,715,403), in view of Yoshiura et al. (US Pat. 5,715,403), and in view of Johnson et al. (US Pat. 6,591,250).

This claim is merely and broadly directed to an authorization to make an extra copy of digital content after receiving a request, reviewing usage conditions, and authorize to make copies.

Stefik did suggests a method on an end user system for updating previously stored usage conditions (see Stefik, the abstract for usage rights) to allow additional copies of previously received encrypted digital content to be made on a computer readable medium (see Stefik, 45:4-9), comprising:

Serial Number: 09/711,747

Art Unit 3661

- receiving a request from a user/"Repository 2" to create a copy of previously received encrypted digital content with associated usage conditions (see Stefik, Fig.1, ref. 104);
- reviewing the associated usage conditions to determine if said additional copy has been authorized (see Stefik, Fig.1, ref. 105); and then
- transmitting said digital work to Repository 2 - in another word, creating said copy onto a computer-readable medium (see Stefik, Fig.1, ref. 107).

Stefik does not disclose about comparing a stored hash value.

However, Yoshiura et al. suggest those actions (see Yoshiura et al., 2:11-19, Fig.9 ref. 1101-1, Fig.4 ref. S402; Fig. 24, refs. 2408, 2409,2404, and 2:45-50, 14:12-20).

Stefik teaches a use of a hash function for verification (another example is Johnson et al. (US Pat. 6,591,250) wherein a software token, and a hash value were used in electronic transaction for authentication, and verification 1:36-45, and 10:1-17). They are in the same field of endeavor and the use of a hash to obtain additional copy is old and well-known (please known that Stefik already suggests a claimed "intent-of-use" for "one additional copy has been authorized in the usage conditions associated with the previously received encrypted digital

Serial Number: 09/711,747

Art Unit 3661

content and without the need to re-receive the encrypted digital content being copied", see Stefik, Fig.14 "Right 1450" and "Copy Count 1453", Fig.15, line 1502, and 1510 for counting number of allowable copies).

It would have been obvious to one of ordinary skill in the art at the time of invention to substitute Stefik's token with Johnson et al.'s a stored hash value and comparing a first hash value and a second hash value for authorizing to make an additional copy of a digital content product because Johnson et al. suggest about a comparison of 2 different hash values sending at 2 different times to a user; this increases a level of verification to prevent unauthorized copying of digital contents.

a. Per claim 7: Stefik obviously suggests about sending a request over a telecommunications infrastructure from the end user system to an electronic store for the permission to create additional copy of the previously received encrypted digital content (see Stefik, 45:4-9).

Stefik does not disclose about: receiving from the electronic store a description of the previously received encrypted digital content requested to be copied with an associated hash value; and comparing the hash value received with a previously stored hash value to determine if they are

Serial Number: 09/711,747

Art Unit 3661

identical and if the hash value is not identical not authorizing additional copy to be made.

However, Yoshiura et al. suggest those actions (see Yoshiura et al., 2:11-19, Fig.9 ref. 1101-1, Fig.4 ref. S402; Fig. 24, refs. 2408, 2409,2404, and 2:45-50, 14:12-20).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Stefik and Yoshiura et al. in comparing a first hash value and a second hash value for authorizing to make an additional copy of a digital content product because Yoshiura et al. suggest about a comparison of 2 different hash values sending at 2 different times to a user; this increases a level of verification to prevent unauthorized copying of digital contents.

b. Per independent claim 15: It is directed to a computer program product to perform the method of claim 1; therefore, an obviousness rejection based on 35 USC 103(a) (using Stefik, Johnson et al., and Yoshiura et al.) is also applied to claim 15.

c. Per independent claims 9, 15, and 18: They are directed to a computer program product to perform the method of claim 1 (see Yoshiura et al., 9:47-49, and 8:24-25); therefore, an obviousness rejection are also applied.

Serial Number: 09/711,747

Art Unit 3661

d. Per dependent claims 3, 11, 19: Yoshiura et al. also suggest to creating an additional copy includes by decrypting the previously received encrypted digital content in a tamper resistant environment (see Yoshiura et al., Fig.5 and 1:50-53).

e. Per dependent claims 4, 12, 20: Yoshiura et al. also suggest a step of creating an additional copy on a computer readable medium selected from computer readable mediums such as recordable CDs, DVDs, Zip Disks, tape, Flash memory, and RAM (see Yoshiura et al., 33:4-9).

f. Per dependent claims 5, 13, 21: Yoshiura et al. also suggest a step of receiving encrypted digital content if the additional copy has not been authorized (see Yoshiura et al., Fig.4 ref. S402).

g. Per dependent claims 6, 14, 22: The rationales and references for rejection of claim 2 are incorporated.

Stefik also suggests of sending payment information from a user system to an electronic store for payment of any additional copy of the previously received encrypted content (See Stefik, Fig.3 and 8:21-29).

h. Per dependent claims 8, 16:

Yoshiura et al. also suggest a step of creating an additional copy of an encrypted content onto a computer readable



Serial Number: 09/711,747

Art Unit 3661

medium by decrypting the encrypted digital content in a tamper resistant environment (see Yoshiura et al., 1:47-55).

Stefik teaches a use of a hash function for verification (another example is Johnson et al. (US Pat. 6,591,250) wherein a software token, and a hash value were used in electronic transaction for authentication, and verification 1:36-45, and 10:1-17). They are in the same field of endeavor and the use of a hash to obtain additional copy is old and well-known (please known that Stefik already suggests a claimed "intent-of-use" for "one additional copy has been authorized in the usage conditions associated with the previously received encrypted digital content and without the need to re-receive the encrypted digital content being copied", see Stefik, Fig.14 "Right 1450" and "Copy Count 1453", Fig.15, line 1502, and 1510 for counting number of allowable copies).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Stefik, Johnson et al., and Yoshiura et al. in comparing a first hash value and a second hash value for authorizing to make an additional copy of a digital content product because Johnson et al. suggest about a comparison of 2 different hash values sending at 2 different times to a user; this increases a level of verification to prevent unauthorized copying of digital contents.

Serial Number: 09/711,747  
Art Unit 3661

### Conclusion

5. Pending claims are not patentable. The submitted amendment necessitate new grounds of rejection; accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose telephone number is 703-305-4553. The examiner can normally be reached on 7:15am - 3:45pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas G. Black can be reached on 703-305-8233. The fax phone number for the

Serial Number: 09/711,747

Art Unit 3661

organization where this application is assigned is 703-305-7687.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Cuong H. Nguyen*

*CAN*  
CUONG H. NGUYEN  
Primary Examiner  
Art Unit 3661